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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,087	06/27/2003	Fernando C. Vidaurri JR.	CPCM:0002-1/FLE 33776US	7544

7590 01/13/2005

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EXAMINER	
BUTTNER, DAVID J	

ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/609,087	VIDAURRI ET AL.	
	Examiner	Art Unit	
	David Buttner	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 and 35-69 is/are pending in the application.

4a) Of the above claim(s) 51-59 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1,35-50,60-69 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1,35-50 and 60-69, drawn to a method of polymerizing PPS, classified in class 528, subclass 388.

II. Claims 51-59, drawn to a method of a making a solution of a sulfur compound in alkali metal aminoalkanoate, classified in class 252, subclass 182.28.

The inventions are distinct, each from the other because:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions produce different products. I produces a polymer while II produces a solution of sulfur compound in alkali metal aminoalkanoate (not a polymer). Furthermore, most of group I's claims require a specific reactor, while II does not.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Michael Fletcher on 1/12/05 a provisional election was made without traverse to prosecute the invention of I, claims 1,35-50 and 60-69. Affirmation of this election must be made by applicant in replying to this Office action. Claims 51-59 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The preliminary amendement of 6/27/03 has added new matter relative to the parent application. If the new matter is to remain, this application must be redesignated as a CIP and new oath be submitted (MPEP 608.04(b) ; 714.01(e)).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35,36,42-50 and 61-69 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The effective filing date for these claims is 6/27/03.

The temperatures 118^0 C, 105^0 C, 110^0 C and 205^0 C do not appear in the specification or in the specification of the parent. New matter includes specific percentages within a broader disclosure (MPEP 760.03(o)). Applicant must point out specifically where the specification supports any future amendment as required by MPEP 2163.06.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39,47 and 67 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The specific compound named in these claims lack the necessary metal.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35,36,42-50 and 61-69 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 01/49706.

This reference is the PCT publication of applicant's parent. The reference exemplifies a first temperature of 100^0 C and a heating step at 204^0 C in example II. These values anticipate the "new matter" ranges, yet do not serve as support for the full range of the claims. Rejecting a claim over the parent publication and simultaneously deny priority is proper in this situation (In re Lukach 169USPQ795).

Claims 42-50 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Senga '469.

Sega exemplifies (No. 1) reacting NaOH, and N-methylpyrrolidone in water at 118^0C. This is applicant's first step . The temperature is raised to 186^0C to distill off water. Senga (col. 3, line 7-11) clearly suggests dehydrating the metal aminoalkanoate.

This meets applicant's next step. Senga further isolates the sodium N-methyl amino butyrate into a dry state.

Senga adds the dry sodium N-methyl amino butyrate to fresh N-methyl pyrrolidone and sodium hydrosulfide and distills off water at 202^0 C (col. 8 line 10-17). This is applicant's next step, with the exception that a dry-rather than a solution of sodium N-methyl amino butyrate is employed. Finally, lithium chloride and dichlorobenzene is added and polymerization carried out (col. 8, line 33-37) which is applicant's last step.

It is apparent that isolating the dry metal aminoalkanoate was carried out merely to perform tests to confirm the identity of the compound.

In a commercial process, the time and expense of this isolation (i.e. removal of excess N methylpyrrolidone which acts as a solvent) would not be carried out except for random quality control checks. This is especially true in view of the fact fresh N methyl pyrrolidone is added along with the sodium hydrosulfide (col. 8, line 13).

It is readily apparent to one of ordinary skill to mix the dehydrated N-methylpyrrolidone/sodium aminobutyrate solution directly with the sulfur source.

Further, Senga states that the reactants can be added to the polar solvent (i.e. N-methylpyrrolidone) in any order (col. 6 line 11). This also suggests combining the sodium amino butyrate and N-methylpyrrolidone prior to adding the sulfur source. This would result in the solution applicant calls for in the third step.

Claims 1,35-50 and 60-69 rejected under 35 U.S.C. 103(a) as being unpatentable over Senga '469 in view of Koyama '433.

Senga does not teach what his reactor is made of. Koyama (col 5 line 56-60) teaches some specific stainless steel alloy reactors are corrosion resistant when polymerizing PPS.

It would have been obvious to use these alloys as the reactor for making Senga's PPS to decrease corrosion. Inherently, the low metal ppm must result because Senga uses the same polymerization procedure as applicant

Claims 42-50 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Campbell '356.

Campbell reacts NaOH with methylpyrrolidone in water at 118^0 C, which distills off the water (col. 5, line 43-49). This meets applicant's first and second steps. Sodium bisulfide is added and heated to distill off more water (col 3 line 36-42). This is applicant's next two steps.

Finally, dichlorobenzene is added and polymerization is commenced (col. 3, line 4). This meets applicant's last step.

Claims 1,35-50 and 60-69 rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell '356 in view of Koyama '433.

Campbell does not teach what his reactor is made of. Koyama (col 5 line 56-60) teaches some specific stainless steel alloy reactors are corrosion resistant when polymerizing PPS.

It would have been obvious to use these alloys as the reactor for making Campbell's PPS to decrease corrosion. Inherently, the low metal ppm must result because Campbell uses the same polymerization procedure as applicant

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner
1/12/05